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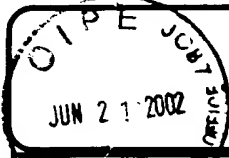
CPA 11636

PTO/SB/29 (10-00)

Approved for use through 10/31/2002 OMB 0651-0032

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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# CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing  
(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

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Washington, D.C. 20231**

|  |                    |
|--|--------------------|
| Attorney Docket No. of Prior Application | 00801.0137.US07    |
| First Named Inventor                     | Monto H. Kumagai   |
| Examiner Name                            | Leffers Jr. G. Jr. |
| Group Art Unit                           | 1636               |
| Express Mail Label No                    | EL615211308US      |

This is a request for a ☐ continuation or ☒ divisional application under 37 CFR 1.53(d),  
(continued prosecution application (CPA)) of prior application number 09 / 359,300 ,  
filed on July 21, 1999, entitled Method of Determining the Presence of a Trait by Transfecting a Nucleic Acid Sequence of a Non-Plant Donor into a Host Plant in a Positive Sense Orientation

## NOTES

**FILING QUALIFICATIONS:** The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).

**C-I-P NOT PERMITTED:** A continuation-in-part application cannot be filed as a CPA under 27 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

**EXPRESS ABANDONMENT OF PRIOR APPLICATION:** The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

**ACCESS TO PRIOR APPLICATION:** The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

**35 U.S.C. 120 STATEMENT:** In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization PTO-2038.

- ☐ Enter the unentered amendment previously filed on \_\_\_\_\_ under 37 CFR 1.116 in the prior nonprovisional application.
- ☒ A Preliminary Amendment including a Response to Office Action is enclosed.
- This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4).
  - ☐ **DELETE** the following inventor(s) named in the prior nonprovisional application:  
 \_\_\_\_\_  
 \_\_\_\_\_
  - ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
- ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
- ☐ Information Disclosure Statement (IDS) is enclosed:
  - ☐ PTO-1449
  - ☐ Copies of IDS Citations

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.** SEND TO: Commissioner for Patents, Box CPA, Washington, DC 20231

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| CLAIMS  | (1) FOR | (2) NUMBER FIELD | (3) NUMBER EXTRA | (4) RATE                      | (5) CALCULATIONS |
|---|---------|------------------|------------------|-------------------------------|------------------|
| TOTAL CLAIMS<br>(37 CFR 1.16(c) or (j))   |         | 12-20 =          | 0                | x \$0.00 =                    | \$0.00           |
| INDEPENDENT CLAIMS<br>(37 CFR 1.16(b) OR (i))   |         | 1-3 =            | 0                | x \$0.00 =                    | 0.00             |
| MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))  |         |                  |                  | x \$0.00 =                    | 0.00             |
|   |         |                  |                  | BASIC FEE<br>(37 CFR 1.16)    | 740.00           |
|   |         |                  |                  | Total of above Calculations = | 740.00           |
| Reduction by 50% for filing by small entity (Note 37 CFR 1.27).   |         |                  |                  |                               |                  |
| * Reissue claims in excess of 20 and over original patent.<br>** Reissue independent claims over original patent. |         |                  |                  |                               |                  |
|   |         |                  |                  | TOTAL =                       | 740.00           |

6. ☐ Small entity status: Applicant claims small entity status. See 37 CFR 1.27.

7. The Commissioner is hereby authorized to credit overpayments or charge any fee deficiency to Deposit Account No. 08 - 3038:

a. ☒ Fees required under 37 CFR. 1.16.

b. ☒ Fees required under 37 CFR 1.17.

c. ☒ Fees required under 37 CFR 1.18.

8. ☒ A check in the amount of \$740.00.00 is enclosed.

9. ☐ Payment by credit card. Form PTO-2038 is attached.

10. ☐ Applicant requests suspension of action under 37 CFR 1.103(b) for a period of \_\_\_\_\_ months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.

11. ☐ New Attorney Docket Number, if desired  
(Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.)

12. ☐ a. Receipt For Facsimile Transmitted CPA (PTO/SB/29A)  
☒ b. Return Receipt Postcard (Should be specifically itemized, See MPEP 503)

13. ☒ Other: Marked-Up Version Showing Changes Made in the Title; Marked-Up Version Showing Changes Made in the Claims

**NOTE:**

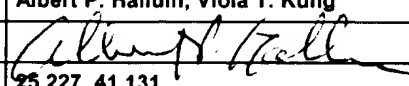
The prior application's correspondence address will carry over to this CPA  
UNLESS a new correspondence address is provided below.

**14. NEW CORRESPONDENCE ADDRESS**

☒ Customer Number of Bar Code Label 27194 or ☐ New correspondence address below  
(Insert Customer No. or Attach bar code label here)

|         |                                  |           |              |          |              |
|---------|----------------------------------|-----------|--------------|----------|--------------|
| Name    | Albert P. Halluin                |           |              |          |              |
|         | Howrey Simon Arnold & White, LLP |           |              |          |              |
| Address | 301 Ravenswood Avenue            |           |              |          |              |
|         | Box 34                           |           |              |          |              |
| City    | Menlo Park                       | State     | CA           | Zip Code | 95025        |
| Country | USA                              | Telephone | 650-463-8109 | Fax      | 650-463-8400 |

**15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

|                                   |  |
|-----------------------------------|--|
| Name (Print/Type)                 | Albert P. Halluin, Viola T. Kung   |
| Signature                         |  |
| Registration No. (Attorney/Agent) | 25,227, 41,131   |
| Date                              | June 21, 2002  |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

Monto H. KUMAGAI, *et.al.*

Application Serial No. 09/359,300

Filed: July 21, 1999

For: **METHOD OF DETERMINING THE  
PRESENCE OF A TRAIT BY  
TRANSFECTING A NUCLEIC ACID  
SEQUENCE OF A NON-PLANT  
DONOR INTO A HOST PLANT IN A  
POSITIVE SENSE ORIENTATION**

Art Unit: 1636

Examiner: Leffers Jr., G.

Attorney's Docket No: 08010137US07

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**PRELIMINARY AMENDMENT AND RESPONSE TO OFFICE ACTION**

**BOX CPA**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is a Preliminary Amendment and Response to Office Action dated April 24, 2002. The Examiner is respectfully requested to enter the amendments and reconsider the application.

**AMENDMENT**

**In the Title**

Page 1, starting line 1, please replace the title with the following title:

METHOD OF DETERMINING THE PRESENCE OF A TRAIT BY TRANSFECTING  
A NUCLEIC ACID SEQUENCE OF A NON-PLANT DONOR INTO A HOST PLANT IN  
A POSITIVE SENSE ORIENTATION.

**In the Claims**

45. (Five Times Amended) A method of determining the presence of a trait in a  
plant, comprising: